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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,147	08/30/2006	Ryoichi Imanaka	TAM-066	6163
20374 7590 12/23/2008 KUBOVCIK & KUBOVCIK SUITE 1105 1215 SOUTH CLARK STREET ARLINGTON, VA 22202				
EXAMINER LUNDGREN, JEFFREY S				
ART UNIT		PAPER NUMBER		
1639				
MAIL DATE		DELIVERY MODE		
12/23/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/591,147

Applicant(s)

IMANAKA ET AL.

Examiner

JEFFREY S. LUNDGREN

Art Unit

1639

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-27 is/are pending in the application.
- 4a) Of the above claim(s) 11-14 and 16-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 8/30/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

Applicants' election without traverse of Group III, claim 15, in the reply filed on October 10, 2008, is acknowledged.

Claims 11-27 are pending in the instant application; claims 11-14 and 16-27 are withdrawn as being directed to a non-elected invention; claim 15 is the subject of the Office Action below.

Foreign Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on August 30, 2006, has been considered by the Examiner. The submission is in compliance with the provisions of 37 CFR § 1.97. Enclosed with this Office Action is a return copy of the Form PTO-1449 with the Examiner's initials and signature indicating those references that have been considered.

Objection to the Abstract Under 37 C.F.R. § 1.72

The abstract of the disclosure is objected to because it does not allow the public generally to determine quickly from a cursory inspection the nature and gist of the invention. Applicants should amend the abstract so that it corresponds to at least one independent claim. For example, Applicants should describe the invention captured by claim 15. See 37 C.F.R. § 1.72. Should Applicants amend the claims in their next reply, the amended abstract should take into account any further limitations added to the broadest independent claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 15 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 is indefinite for reciting the second occurrence of the phrase “specifying the storing region” because it is not clear which “storing region” Applicants are referencing. For example, Applicants already have introduced the phrases “forming a storing region” and “two or more storing regions” in the claim.

Claim 15 is indefinite for reciting the phrase “specifying the storing region by reading the address showing a predetermined region by the optical beam” because the metes and bounds cannot reasonably be determined. For example, the term “specifying” appears to indicate a “writing” step, not a reading step as set forth in the claim. Perhaps this is the result of a translation error from the priority document.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Dower *et al.*, U.S. Patent No. 5,770,358, issued on June 23, 1998.

Claim 1 is directed towards a method of forming a microarray by protective group of nucleotide which comprises forming a storing region and an address specifying the storing region on a track which can be tracked by an optical beam on a substrate; arranging a nucleotide having a protective group in two or more storing regions; specifying the storing region by reading the address showing a predetermined region by the optical beam; irradiating the stored nucleotide having a protective group by the above-mentioned optical beam; removing the protective group of the nucleotide having the protective group stored in the storing region.

Dower teaches a general stochastic method for synthesizing random oligomers can be used to synthesize compounds to screen for desired properties. The use of identification tags on the oligomers facilitates identification of oligomers with desired properties (see Abstract). The oligomers are prepared by light-directed methodologies using protected oligonucleotides that are deprotected by light or chemical reagents. Dower also teaches the use of preparing "storing regions" or encoded regions that identify the chemical structures on the substrate:

"The identifier tag may be any recognizable feature that is, for example: microscopically distinguishable in shape, size, color, optical density, etc.; differently absorbing or emitting of light; chemically reactive; magnetically or electronically encoded; or in some other way distinctively marked with the required information, and decipherable at the level of one (or few) solid supports. In one embodiment, each bead or other solid support in the library incorporates a variety of fluorophores, or other light addressable type of molecules, the spectral properties of which can be changed and therefore used to store information. In one such mode, a bead incorporates a variety of fluorophors, each of which can be selectively photobleached, and so rendered incapable of fluorescence or of diminished fluorescence. During each coupling step, the bead is irradiated (or not) to photobleach (or not) one or more particular types of fluorophors, thus recording the monomer identity in the oligomer synthesized. See Science 255: 1213 (6 Mar. 1992), incorporated herein by reference.

One can construct microscopically identifiable tags as small beads of recognizably different sizes, shapes, or colors, or labeled with bar codes. The tags can be "machine readable" luminescent or radioactive labels. The identifier tag can also be an encodable molecular structure. The information may be encoded in the size (the length of a polymer) or the composition of the molecule. The best example of this latter type of tag is a nucleic acid sequence, i.e., RNA or DNA assembled from natural or modified bases."

Dower, col. 15, lines 9-37; see also col. 14, line 12 through col. 15, line 6 for further description regarding the encoding process.

Accordingly, claim 15 is anticipated.

Conclusions

No claim is allowable.

If Applicants should amendment the claims, a complete and responsive reply will clearly identify where support can be found in the disclosure for each amendment. Applicants should point to the page and line numbers of the application corresponding to each amendment, and provide any statements that might help to identify support for the claimed invention (*e.g.*, if the amendment is not supported *in ipsiis verbis*, clarification on the record may be helpful). Should Applicants present new claims, Applicants should clearly identify where support can be found in the disclosure.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jeff Lundgren whose telephone number is 571-272-5541. The Examiner can normally be reached from 7:00 AM to 5:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Christopher Low, can be reached on 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffrey S. Lundgren/
Patent Examiner, Art Unit 1639